

REMARKS:

Claims 1-29 are pending. Of these, claims 1-15, 17, 19 and 24-29 have been found allowable, while claims 16, 18, and 20-23 have been non-finally rejected under 35 U.S.C. 112.

A telephonic interview was conducted on December 15, 2008, between the undersigned and Examiner Anh H. Do. Pursuant to MPEP 713.04, a summary of the interview is provided as follows.

Claims 16, 18, and 20-23 were discussed in the context of the rejection made under 35 U.S.C. 112. No exhibit or demonstration was shown or conducted. No agreement was reached. The Examiner suggested that the applicant add the language "computer readable medium" to the claims to avoid a future rejection under 35 U.S.C. 101.

Turning to the examination on the merits, Claims 16, 18, and 20-23 were rejected under 35 U.S.C. 112, first paragraph, for not being enabled by the disclosure. This rejection is respectfully traversed.

The Examiner contends that one of ordinary skill in the art would not understand how to make or use the invention in claims 16, 18 and 20-23 due to the recitation of "computer programs" that are not explicitly disclosed in the application. The subject claims specifically reference the names of the data processing routines used in JPEG encoding and the names assigned under the JPEG standard to pieces of the JPEG code blocks. Thus, claims 16, 18 and 20-23 do not recite

"computer programs," they recite method steps being performed on data structures that are defined under the JPEG standards.

To support an enablement rejection, "the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement." MPEP 2164.04. Here, the Examiner merely states, "[t]he computer programs recited in these claims may not enable one of ordinary skill in the art to make and/or use the invention." However, the Examiner does not mention why he thinks the "computer programs" "may not enable" a person of ordinary skill in the art to make or use the invention. Hence, the Examiner has failed to carry his burden of showing a lack of enablement.

Nonetheless, even if the Examiner had articulated a reason, a person of ordinary skill in the art would be familiar with the JPEG standards and standard JPEG encoding schemes recited in claims at issue (see Declaration of Dr. Michael W. Marcellin, paragraphs 7 and 8). In fact, the applicants have disclosed numerous background references related to JPEG coding and the JPEG standards themselves (for example, the "Background" section of the application references ISO/IEC 15444-1:2004, "JPEG2000 Image Coding System;" D. S. Taubman and M. W. Marcellin, JPEG2000: Image Compression Fundamentals, Practice and Standards, Kluwer Academic Publishers, Boston, 2002; or M.J. Gormish, A. Bilgin and M.P. Boliek, "An overview of JPEG-2000", Data Compression Conference, pp. 523-541, March 2000, Snowbird, UT).

In view of the Declaration attesting to the facts that (1) the routines and standards described in claims 16, 18 and 20-23 are background information, and that (2) the person of ordinary skill in

the art would be able to apply the method recited in claims 16, 18 and 20-23 to the data structures under the encoding conditions recited therein, the practice of these claims is enabled.

Regarding the Examiner's suggestion that the phrase "computer readable medium" be added to the independent method claims to recite a machine implementable quality thereto (such that a rejection under 35 U.S.C. 101 would be obviated), said claims have been amended accordingly. As independent claim 28 recites a display device and not a method, it remains unchanged.

Regarding the objection to the drawings, it appears that the Patent Office mistakenly entered a sheet of figures that was merely an exhibit to the arguments section of the Preliminary Amendment filed with this case (no such entry direction was provided by the applicants). Nonetheless, a replacement sheet for Figs. 1 and 2 has been provided herewith to return these figures to those originally filed upon entry of the National Stage of this application.

In view of the above, the applicants respectfully submit that all of the claims define patentable subject matter. Other than the fee due for a three-month extension of time, no fee is believed to be due with this amendment. Should there be any unforeseen costs, please charge our Deposit Account No. 17-0055.

Respectfully submitted,

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